

Remarks/Arguments

In response to the Office Action mailed June 1, 2005, Applicant submits this Amendment. A complete listing of all pending claims is submitted herewith.

In the Office Action, the Examiner has requested that a new Declaration be submitted, which is filed herewith. Claims 1-20 are rejected under the judicially created doctrine of obviousness type double patenting. Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,286,003 to Muta (the “Muta” patent) in view of U.S. Patent No. 6,233,609 to Mittal (the “Mittal” patent). Claim 9 is rejected as being obvious over Muta in view of Mittal and further in view of U.S. Patent No. 6,011,918 to Cohen et al. (the “Cohen” patent). By this amendment, Figures 9(a) and 9(b) has been amended. Claims 1, 9, 10, 12, 15, and 18 have been amended for formalities only, and not to overcome rejections related to patentability. No new matter has been added by the current amendments. For reasons to be set forth below, it is requested that the rejections be withdrawn and that the claims be allowed to issue.

The Drawings

Figures 9(a) and 9(b) have been amended to correct several typographical errors. In particular, the text of the figures has been revised to accurately reflect upper and lower case text. In addition, the figures have been revised to reflect typographical errors in the several parentheses. The revisions to the drawings more accurately conform to the informal drawings originally filed with this application. No new matter has been added.

The Provisional Double-Patenting Rejection

Claims 1-20 are provisionally rejected under the judicially created doctrine of double-patenting as being unpatentable over claims 1-20 of copending Application No. 10/296,193. Both Application No. 10/296,193 and the above-referenced application are commonly assigned to the Trustees of Columbia University.¹ The provisional rejection is

¹ An assignment for the above-referenced application to the Trustees of Columbia University is submitted herewith.

acknowledged by Applicants; however, no further action is believed necessary unless there is an allegation that otherwise *allowable* claims are believed patentably indistinct.

The Rejection under 35. U.S.C. §103

Claims 1-8 and 10-20 are rejected under 35 U.S.C. § 103(a) as being obvious over Muta in view of Mittal. The rejection is respectfully traversed.

In rejecting Claim 1, the Examiner has acknowledged that Muta neither discloses nor suggests all of the features of claim 1. For example, the Examiner states that “Muta...does not expressly disclose the limitation wherein the respective function is only performed at the remote client.”² The Examiner then suggests that “[i]t would have been obvious...to modify the method of Muta such that the respective function is only performed at the remote client, as taught by Mittal, so that a plurality of clients can interact with the application independently.”³

The proposed modification of Muta in view of Mittal is believed improper. In order to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine referenced teachings. However, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.⁴

In this case, the proposed combination of Muta and Mittal would require a substantial reconstruction and redesign of the elements shown in Muta as well as a change in the basic principle under which Muta was designed to operate. For example, Muta states that it is an “objective of the present invention to *reduce* the use of resources by a remote controlling terminal,” i.e., the client.⁵ In order to achieve this reduction of the use of resources at the client, “remote controlling software” is downloaded to the

² Office Action, June 1, 2005, Page 9, ¶3.

³ Office Action, June 1, 2005, Page 9, ¶5.

⁴ *In re Ratti*, 270 F.2d 810 (CCPA 1959).

⁵ Muta, column 2, lines 11-12, *emphasis supplied*.

client⁶, and the more intensive *functions* are performed at the *server*, which is therefore referred to as the “slave server.” In particular, the window system 320, Graphics engine 321, drawing command monitor 323, and the display driver 325 are located on the slave server 240⁷. The data generated by the Graphics engine 321 on the server is then sent to the master controller 210 via the drawing command buffer 327 and drawing command sender 329,⁸ such that graphics are redrawn at the master controller.⁹

Mittal describes an entirely different principle of operation. In direct contrast to Muta, the Examiner notes that “the *functions* of the user interface [of Mittal] are performed *only* at the remote client”.¹⁰ For example, Mittal describes that the GUI software 145 is downloaded onto the client 33¹¹, such that the “display capability” of the GUI 145 resides only on the client 33¹².

Accordingly, the modification proposed by the Examiner, i.e., changing Muta so that an interface function is performed entirely at the *client*, would substantially alter its operation, which is to locate intensive drawing functions on the slave *server* and transmit drawing commands to the client. This drastic reconstruction and redesign of Muta is evidence of nonobviousness, as provided in MPEP Section 2143.01. Accordingly, claim 1 is believed allowable. Claims 2-9, which depend from claim 1 are believed allowable at least for the reasons discussed above with respect to claim 1.

Claim 10 is allowable for the same reasons discussed above for claim 1. For example, the proposed combination of Muta in view of Mittal is believed improper. Accordingly, Claim 10 is not believed anticipated by Muta in view of Mittal. Claims 11-20 depend from claim 10 are allowable at least for the reasons discussed above for claim 10. It is requested that the rejection of claims 1-8 and 10-20 under 35 U.S.C. § 103(a) as obvious over Muta in view of Mittal be withdrawn.

⁶ Muta, column 2, lines 37-38.

⁷ Muta, Figure 8; column 10, line 56 - column 11, line 21.

⁸ Muta, Figure 14, column 11, lines 13-39.

⁹ Muta, column 11, lines 56-58.

¹⁰ Office Action, June 1, 2005, page 9, ¶4, emphasis supplied.

¹¹ Mittal, column 6, line 64-66.

¹² Mittal, column 6, line 67 - column 7, line 1.

Claim 9 is rejected as being obvious over Muta in view of Cohen. Applicants' arguments in the Amendments dated April 29, 2004 and February 11, 2005 are preserved herein. Claim 9 depends from claims 1 and is believed allowable at least for the reasons discussed above with respect to claims 1.

To establish obviousness, the prior art must teach or suggest all of the claim limitations.¹³ Neither Muta nor Cohen, either alone or in combination, disclose or suggest the step of "substituting said at least one portion of the code relevant to executing the function with the portion of code configured to issue the remote command to execute the function" as recited in claim 9. The Examiner states that Muta alone discloses this step, i.e., "[t]he graphics engine 321 and the display driver 325 constitute 'the portion of code relevant to executing this function.'"¹⁴ Without conceding the Examiner's assertion, Applicants do not understand how it proves the Examiner's point. As has been previously discussed, the graphics engine 321 and display driver 325 perform the function of generating drawing images on the server. Claim 9, in contrast, recites "*substituting* the portion of the code relevant to executing the function" (emphasis supplied). If the graphics engine 321 and the display driver 325 perform the drawing function on the server, Applicants fail to see that such function has been *substituted*, i.e., replaced, with "code configured to issue the remote command to execute the function." Cohen fails to make up for the deficiency of Muta. Accordingly, claim 9 is believed non-obvious over the combined references. It is requested that the rejection be withdrawn.

¹³ *In re Royka*, 490 F.2d 981 (CCPA 1974).

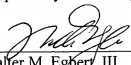
¹⁴ Office Action, June 1, 2005, page 3, ¶5.

Conclusion

In view of the foregoing, claims 1-20 are believed allowable, and this application is believed to be in condition for formal allowance. Prompt and favorable action is respectfully requested.

Respectfully submitted,

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By 
Walter M. Egbert, III
Patent Office Reg. No. 37,317

Attorney for Applicants
BAKER BOTTS, L.L.P.
30 Rockefeller Plaza
New York, NY 10112
(212) 408-2561

Amendments to the Drawings

This attached sheet of drawings includes changes to Figures 9(a) and 9(b). This sheet, which includes Figures 9(a) and 9(b), replaces the original sheet including Figures 9(a) and 9(b). In Figures 9(a) and 9(b), the text has been revised to properly reflect upper and lower case text, and to correct typographical errors.

Attachment: Replacement Sheet

Annotated Sheet Showing Changes